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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,839	08/22/2001	Noboru Yanagida	213024US0	7276

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EXAMINER	
REDDICK, MARIE L	

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/933,839	YANAGIDA, NOBORU	
	Examiner	Art Unit	
	Judy M. Reddick	1713	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☒ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: *NONE*.

   Claim(s) objected to: *NONE*.

   Claim(s) rejected: *1-3,6 and 8-10*.

   Claim(s) withdrawn from consideration: *11-20*.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☒ Other: *See Continuation Sheet*

Judy M. Reddick
Primary Examiner
Art Unit: 1713

Continuation of 2. NOTE: The newly proposed claims (21 & 22) raise New Issues (21 & 22), New Matter (21) as well as Issues of indefiniteness (21). As to the New Matter issue, there is no support seen for a range of solvent of less than or equal to 325 % coupled with an amount of catalyst from 0.5 to 20 mole %, as claimed. As to the issue of indefiniteness, "wt.%" or "mole %" relative to the content of "alcohol-based solvent" is not readily ascertainable .

Continuation of 5. does NOT place the application in condition for allowance because: it is urged and maintained that the instantly claimed invention is obvious within the meaning of 35 USC 103 (a) over Hart et al in combination with Hoyt et al and further in combination with Moritani et al'547 or Moritani et al'165 or Takahashi as per reasons clearly stated in the Grounds of Rejection of record per the previous Office Action (06/09/04).

Continuation of 10. Other: The crux of Counsel's arguments appear to hinge on it not being obvious to obtain a degree of saponification that is at least 98 mol % when the water content is from 100 to 15,000, as claimed. Counsel, is herein reminded that a reference is evaluated, as a whole, for what it fairly teaches and is in noway limited to bits and pieces. To this end, Hart et al @ col. 2, lines 30+ teach, basically, that the HEVA(saponified/hydrolyzed ethylene-vinyl acetate copolymers) are produced in accordance to the teachings of U.S. 3,985,719, Hoyt et al) and, as evidenced by Hoyt et al, ethylene-vinyl acetate copolymers having a degree of saponification/hydrolysis as high as 99 mol% in combination with water contents between 100 and 3400 ppm are operable within the scope of patentees invention(col. 9, lines 41-55). Therefore, it would have been obvious to the skilled artisan to modify the degree of saponification/hydrolysis of the ethylene-vinyl acetate copolymer of Hart et al, following the guidelines of Hoyt et al and with a reasonable expectation of success. Even if this turns out not to be the case, it is urged and maintained that it would have been obvious to the skilled artisan to adjust the degree of saponification/hydrolysis of the ethylene/vinyl acetate copolymer of Hart et al via adjusting process parameters such as water content, alcohol content, catalyst content, reaction time, etc. as suggested by Hart et al(col. 3, lines 26-38 and col. 5, lines 22-47) and evidenced by Hoyt et al(col. 5, lines 34-62 & the paragraph bridging cols. 8-9), incorporated by reference(cols. 2 & 3 of Hart et al), and with a reasonable expectation of success and with the understanding that "suitable" is relative and not absolute. Moritani et al and Takahashi et al are relied upon to show that the mechanics of carrying out saponification/hydrolysis of an ethylene-vinyl acetate copolymer via the use of a saponification reaction column is conventional. There is nothing iron-clad on this record diffusing this issue commensurate in scope with the claims.